

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of : Richard Joseph Bennett *et al.*
Application No. : 09/784,889
Filing Date : February 16, 2001
Art Unit : 3626
Title : Method and System for Ordering a Laboratory Test for a Patient and
Obtaining Results Thereof

Attorney : 340005-2012
Docket No. :

Mail Stop Appeal Brief—Patents
Commissioner for Patents
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REPLY BRIEF

I. ARGUMENT

This appeal concerns the rejections of all pending claims under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication no. US 2001/0051880 A1 by Schurenberg *et al.* Rejection of any claim can stand, however, “only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131 (8th ed. [R-5] 2006) (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)). Before rejecting a claim, therefore, the Examiner must interpret that claim and find its elements.

The rules of claim interpretation are long-settled. “The Patent and Trademark Office . . . must consider all claim limitations when determining patentability of an invention over the prior art.” *In re Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994). The words of the claims themselves define the scope of the patented invention. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). And although the Patent and Trademark Office must give these words their broadest reasonable interpretation, that interpretation must be consistent with the one that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1358 (Fed. Cir. 1999).

In this case, The Board must overturn the Examiner because the Examiner ignores these rules. In particular, the Examiner unreasonably interprets some claim terms and simply ignores explicit limitations. And if the Office Actions in the record leave any doubt about this, the Examiner’s Answer removes it.

For example, the Examiner maintains that the middleware server mentioned in Schurenberg is the “central computer” referred to in, *e.g.*, claim 26. (See Advisory Action mailed on September 27, 2006 (the “Advisory Action”), at 2.) But the Examiner has never said what is “central” about the middleware server. The Examiner’s sole statement in this regard remains the assertion in the Advisory Action that “the Examiner interprets ‘middleware server’ to be a form of ‘central computer.’” (Advisory Action at 2.)

Instead of an *interpretation* of the claim term “central computer,” the Examiner rests on a naked *declaration* that Schurenberg anticipates it. But the Applicant has shown previously that

no one skilled in the art would use the term “central computer” when “middleware server” was meant. (*See, e.g.*, Appeal Brief dated April 11, 2007 (“Appeal Brief”), at 5–6.) The Applicant submits that the Examiner’s declaration that “central computer” means “middleware server” is inconsistent with the interpretation that those skilled in the art would reach, that the Examiner has pointed to nothing in the application or the reference that might justify this declaration, and that the rejections are therefore improper.

The Examiner ignores the plain meaning and import of other claim terms. For example, claim 27 includes “analyzing the at least one query at the central computer to *verify* that the requested laboratory test is payable by a responsible party *identified* in the billing information.” (Emphasis added.) On page 12 of the Examiner’s Answer, the Examiner points to paragraph 404 of Schurenberg, asserting that this paragraph shows that a responsible party has been identified. But the claim distinguishes between verification and identification, and the Examiner errs in ignoring that distinction.

The Examiner similarly errs, *e.g.*, elsewhere on page 12 of the Examiner’s Answer, declaring that claim 28’s “searching a code database for correspondence between the diagnosis code and the laboratory code” is anticipated by the mere existence on a single requisition record of both a diagnosis code and a laboratory test code.

But the Examiner in places goes beyond misinterpreting claim terms to ignoring them outright. Claim 26, for example, includes “transmitting information through the network from the central computer, the information including data for generating a test requisition and a label for use with the biological specimen,” and other claims include similar limitations. The Examiner’s Answer asserts that “all that is claimed is a step of transmitting information.”

It is respectfully submitted that the Examiner has ignored a functional limitation, contrary to the express direction of the MPEP:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper.

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.

MPEP § 2173.05(g) (8th ed. [R-5] 2006).

The Federal Circuit routinely gives effect to functional claim limitations. For example, in *Gart v. Logitech, Inc.*, the court considered the claim language: “an angular medial surface for supporting the three remaining ulnar fingers in a wrapped configuration with flexion of the distal, middle, and proximal phalanges of said ulnar fingers.” 254 F.3d 1334, 1340 (Fed. Cir. 2001). The court held that this limitation required an angled surface that satisfied the expressed purpose of supporting the fingers in the described way. *See id.* at 1343.

Here, in claim 26, “generating a test requisition and a label for use with the biological specimen” are the purposes to be served by the information and the transmission of it. These purposes limit the content of the transmitted information and the transmission of it, requiring at least that the transmission take place before a label is printed or a requisition is generated. The Examiner’s refusal to give weight to these limitations was error, and the Board is respectfully requested to overturn the consequent rejections.

II. CONCLUSION

In view of the foregoing, it is believed that all pending claims are in proper condition for allowance, and the Board is respectfully requested to overturn the Examiner’s rejection of these claims.

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